

### REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action.

#### Objections

The abstract was objected to as including more than 150 words. The abstract has been amended to shorten it to be fewer than 150 words. Accordingly, the applicants respectfully submit that this ground of objection should be withdrawn.

#### Rejections under 35 U.S.C. § 102

Claims 15, 19, 35 and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,483,602 ("the Haneda patent"). The applicants respectfully request that the Examiner reconsider and

withdraw this ground of rejection in view of the following.

Before addressing at least some of the patentable features of these claims, the Haneda patent is first introduced. The Haneda patent concerns a film image management system. Referring to Figure 10 of the Haneda patent, undeveloped film is developed and read, and image information is saved to a laboratory disk, printed, and recorded (perhaps in reduced form) on a user disk. Labels with an identification code may be printed and affixed to one or both of a film roll container or envelope, and the user disk. (See, e.g., Figures 3-7.)

In addition to, or instead of, affixing the bar code label to the disk, the identification code may be stored on the disk. Examples of the identification code are listed on column 15, lines 14-48. The label may be provided with human comprehensible characters, symbols, and/or figures. (See, e.g., Figures 8 and 9.)

The identification code and frame identifiers may be used when ordering extra prints (e.g., via a communications network or via a paper order form). For example, such extra prints may be ordered while the user is viewing the images using a playback program. Specifically, the laboratory can use the identification code and frame identifier to retrieve images that the user wants extra prints of. (See, e.g., column 5, lines 29-42.)

Having introduced the Haneda patent above, at least some patentable features of the claims are now discussed.

Independent claims 15 and 35 are not anticipated by the Haneda patent because the Haneda patent does not teach an act of (or means for) rendering information

associated with each of the one or more records accepted, **the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted,** wherein the label is provided on the storage medium without storing it on the storage medium.

The Examiner contends that the printing of extra copies of photographs in the Haneda patent teaches this feature. (See, Paper No. 3/28/2005, page 3.) The applicants respectfully disagree. The Examiner ignores the highlighted claim language which pertains to an important feature of the claimed invention. For example, as described on pages 29 and 30 of the above-captioned application, a "find file" function may accept user search parameters to generate one or more matching database records. Then:

content tracking (non-base)  
operation(s) 242 may then use this information to help the user find the storage medium having the file that they want. It 242 may do so by ***displaying the media key (e.g., a number) and/or the visual cues to the user, so that the user can then use this information to find the storage medium storing the file that they are looking for.*** Alternatively, the content tracking (non-base) operation(s) 242 may then use this information to help the user find the storage medium having the file that they want by ***checking successive scanner inputs for a match with the media key in the returned record(s), and indicating a match or no match (e.g., with audible beeps of different tones) to the user.*** [Emphasis added.]

Page 29, line 27 through page 30, line 7. In the Haneda patent, the information returned (e.g., extra prints) are not related to the label associated with the storage medium storing one or more files identified with the one or more records accepted. Accordingly, independent claims 15 and 35 are not anticipated by the Haneda patent for at least this reason. Since claims 19 and 39 depend from claims 15 and 35, respectively, these claims are similarly not anticipated by the Haneda patent.

Further with regard to dependent claims 19 and 39, these claims further recite that each of the labels include a human-readable part, and that the information associated with each of the one or more records accepted corresponds to the human-readable part of the labels. Although, Figures 8 and 9 (cited by the Examiner) of the Haneda patent do show that labels can include human intelligible parts, in his rejection of claims 15 and 35, the Examiner alleged that the extra copies of the photographs corresponds to the claimed "information" rendered to the user. Clearly, if it is the Examiner's position that the extra copies of the photographs are the claimed "information", such extra copies of photographs are not human intelligible portions of a label applied to a film roll, a film envelope, or a user disk. Thus, claims 19 and 39 are not anticipated by the Haneda patent for at least this additional reason.

In summary, the Haneda patent is much different from embodiments consistent with the present invention. The Examiner equates the label in Haneda with the search parameters in claims 15 and 35. However, the claimed invention determines information about a relevant label (which allows a user to read these labels electronically

or visually). On the other hand, the Haneda patent starts with the label as its input, rather than outputting information pertaining to the label.

Please note that new claim 42, which depends from claim 15, expressly recites that the information rendered is related to the label associated with the storage medium storing one or more files identified with the one or more records accepted ***such that a user or a scanner can distinguish the storage medium including the label from other storage media.*** This further distinguishes the claimed invention over the Haneda patent.

#### **Rejections under 35 U.S.C. § 103**

Claims 1-7, 10-14, 20-26, 29-34, 36 and 40-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Publication No. US 2002/0075514 ("the Wright publication") in view of the Haneda patent. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Before addressing at least some of the patentable features of these claims, the Wright publication is first introduced. The Wright publication concerns document imaging and storing (archiving). Before scanning a document, a label with a globally unique document identifier is affixed to the document, and/or a cover sheet with such a globally unique document identifier is printed out. (See, e.g., paragraph 0044.) The document identifier may be used to link the scanned document image to a database record with a document index. (See, e.g., paragraph 0054.) The index includes meta-data describing

the document, and/or its contents. (See, e.g., paragraph 0053.)

The label may include a bar code and eye-legible information. (See, e.g., paragraphs 0059 and 0060.)

Having introduced the Wright publication (as well as the Haneda patent) above, at least some patentable features of the claims are now discussed.

Independent claims 1 and 20 are not rendered obvious by the Haneda patent and the Wright publication because these references, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) writing the unique volume label onto a storage medium (for which a unique label identifier was already determined). Further, these references, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier. Furthermore, one skilled in the art would not have been motivated to combine these references as proposed by the Examiner. Each of these issues is discussed below.

The Haneda patent and the Wright publication, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) writing the unique volume label onto a storage medium (for which a unique label identifier was already determined). The Examiner contends that the Wright publication teaches determining a globally unique document identifier (on which the claimed determining a unique label identifier for a storage medium reads), performing document indexing (on which the claimed determining a unique volume identifier for the storage medium reads) and scanning the document

(on which writing the unique volume identifier onto the storage medium reads). (See Paper No. 3/28/2005, page 5.)

The applicants respectfully note that the Examiner's rejection relies on an inconsistent interpretation of "storage medium". Specifically, the label with the globally unique document identifier is for a document. Therefore, under the Examiner's interpretation, the document teaches the claimed "storage medium". The indexing does nothing to the document (the Examiner's alleged storage medium) itself. Thus, the Wright publication neither teaches, nor suggests, the claimed act of writing the unique volume label onto the storage medium. The purported teachings of the Haneda patent do not compensate for this deficiency of the Wright publication. Thus, independent claims 1 and 20 are not rendered obvious by the Wright publication and the Haneda patent for at least this reason. Since claims 2-7, 10-14 and 40 depend, either directly or indirectly from claim 1, and since claims 21-26, 29-34, 36 and 41 depend, either directly or indirectly from claim 20, these claims are similarly not rendered obvious by the Wright publication and the Haneda patent.

Further, the Haneda patent and the Wright publication, either taken alone or in combination, neither teach, nor suggest, an act of (or means for) determining whether or not the storage medium has been assigned a both **unique volume label** and **a unique label identifier**. The Examiner concedes that the Wright publication does not teach this feature. To compensate for this deficiency of the Wright patent, the Examiner cites column 14, lines 65-67 of the Haneda patent as

teaching determining whether or not the storage medium has been assigned a unique label identifier. First, even assuming, arguendo, that the Haneda patent includes such a teaching, and further assuming that one skilled in the art would have been motivated to modify the Wright patent as proposed by the Examiner, the resulting combination does not teach determining whether or not the storage medium has been assigned both (1) a **unique volume label** and (2) a **unique label identifier**. Thus, independent claims 1 and 20 are not rendered obvious by the Wright publication and the Haneda patent for at least this reason. Since claims 2-7, 10-14 and 40 depend, either directly or indirectly from claim 1, and since claims 21-26, 29-34, 36 and 41 depend, either directly or indirectly from claim 20, these claims are similarly not rendered obvious by the Wright publication and the Haneda patent.

Finally, one skilled in the art would not have been motivated to combine the purported teachings of the Haneda patent and the Wright publication as proposed by the Examiner. As can be appreciated from the foregoing discussions of the Haneda patent and the Wright publication, the Haneda patent concerns labeling something (e.g., a roll of film, an envelope with film, a user disk, etc.) including images. Such labeling is useful for facilitating the ordering of extra photographic prints from a film processing laboratory. On the other hand, the Wright publication concerns labeling documents scanned and electronically archived. Thus, in the Haneda patent, content (i.e., a document) is labeled, while in the Wright publication, a container (i.e., a roll of film, an envelope of film, or a disk)

including content (e.g., images) is labeled. In this way, these two references are fundamentally different and one skilled in the art would not have been motivated to combine the teachings of these references.

The Haneda patent is relied on as teaching determining whether or not the storage medium has been assigned a unique label identifier, and the Examiner contends that it would have been obvious to have modified the Wright publication to determine whether the scanned document (characterized as the claimed "storage medium" by the Examiner) has a unique label identifier. In the Wright publication, the document is presumably scanned once, and has an associated unique document identifier (either on an affixed label or on a cover sheet). Once the document is scanned, it is presumed to include the unique identifier and there is no advantage to determine whether or not it includes such an identifier. Thus, independent claims 1 and 20 are not rendered obvious by the Wright publication and the Haneda patent for at least this reason. Since claims 2-7, 10-14 and 40 depend, either directly or indirectly from claim 1, and since claims 21-26, 29-34, 36 and 41 depend, either directly or indirectly from claim 20, these claims are similarly not rendered obvious by the Wright publication and the Haneda patent.

Claims 8 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Wright publication and the Haneda patent and further in view of U.S. Patent No. 5,119,291 ("the Flannagan patent"). The applicants respectfully request that the

Examiner reconsider and withdraw this ground of rejection in view of the following.

Since the purported teachings of the Flannagan patent fail to compensate for the deficiencies of the Wright publication and the Haneda patent with respect to claims 1 and 20 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Wright, Haneda and Flannagan references as proposed by the Examiner, such a combination would fail to render the invention of claim 1 and 20, and therefore of claims 8 and 27, unpatentable.

Claims 9 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Wright publication and the Haneda patent and further in view of U.S. Patent No. 4,864,616 ("the Pond patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since the purported teachings of the Pond patent fail to compensate for the deficiencies of the Wright publication and the Haneda patent with respect to claims 1 and 20 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Wright, Haneda and Pond references as proposed by the Examiner, such a combination would fail to render the invention of claim 1 and 20, and therefore of claims 9 and 28, unpatentable.

Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Haneda patent and further in view of U.S. Patent No. 5,971,279 ("the Raistrick patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since the purported teachings of the Raistrick patent fail to compensate for the deficiencies of the Haneda patent with respect to claim 15 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Raistrick patents as proposed by the Examiner, such a combination would fail to render the invention of claim 15, and therefore of claims 16-18, unpatentable.

Claims 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Wright publication and the Haneda patent and further in view of the Raistrick patent. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since the purported teachings of the Raistrick patent fail to compensate for the deficiencies of the Haneda patent with respect to claim 35 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Raistrick patents as proposed by the Examiner, such a combination would fail to render the invention of claim 35, and therefore of claims 37 and 38, unpatentable.

### **New claims**

New claim 42 depends from claim 15 and further distinguishes the claimed invention over the cited art for reasons discussed above. This claim is supported, for example, by page 29, line 27 through page 30, line 7.

New claim 43 depends from claim 1 and further positively recites updating the database based on files deleted from the storage medium. This feature is supported, for example, by block 330 of Figure 3, and further distinguishes the claimed invention over the cited art. Specifically, the Wright publication and the Haneda patent both assume that the content of the storage medium doesn't change. In the Wright publication, the storage medium is a paper document. In the Haneda patent, it is a disk related to the contents of a developed roll of photographic film. Contents of both a printed document and of a developed roll of film are static.

### **Amendments to the Specification**

The specification has been amended to reduce the length of the abstract.

### **Conclusion**

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

October 11, 2005

John C. Pokotylo  
John C. Pokotylo, Attorney  
Reg. No. 36,242  
Tel.: (732) 542-9070

**CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)**

I hereby certify that this correspondence is being deposited on **October 11, 2005** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

John C. Pokotylo  
John C. Pokotylo

36,242  
Reg. No.